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EXAMINER

ROSEN, N

ART UNIT

PAPER NUMBER

2165

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
**09/199,566**

Applicant(s)

**Saito et al.**

Examiner  
**Nicholas Rosen**

Art Unit  
**2165**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Aug 8, 2001
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some\* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

Art Unit: 2165

1. Claims 1-37 have been examined.

***Continued Prosecution Application***

2. The request filed on August 8, 2001, for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/199,566 is acceptable and a CPA has been established. An action on the CPA follows.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Art Unit: 2165

5. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe (U.S. Patent 5,717,776) in view of Sukegawa et al. Watanabe discloses an identification document transaction apparatus connected to a residents database storing therein identification data of the residents and also connected to a center which executes an examination for issuance of identification documents through a communication line, said apparatus comprising: a communication unit for communicating with said center (column 12, lines 31-33; see also Figure 10A); an image input unit for inputting an image of the applicant for an identification document (column 15, lines 1-31); and a data input unit for inputting data for the application (column 15, lines 21-40).

a. Watanabe does not expressly disclose a display unit for displaying a guidance for the procedure for the identification document transaction, but Sukegawa et al. teach this (Figure 7; column 3, lines 21-24; column 8, lines 27-35 et subseq.). Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to include a display unit for displaying a guidance for the procedure, for the obvious advantage of making applicants more likely to carry out the procedure correctly.

b. Watanabe does not expressly disclose a sign input unit for inputting a sign of the applicant, but official notice is taken that it is well known to use sign input units for inputting a sign of an applicant. (For example, Examiner inputted his signature into such a unit to have a reproduction of his signature printed on his Virginia driver's license.) Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of

Art Unit: 2165

applicant's invention to include such a sign input unit, for the obvious advantage of obtaining the identification document applicant's signature for the identification document and/or for issuer's records.

c. Watanabe does not expressly disclose a control section for transmitting the data inputted by each of the input units to the center using the communication unit, but it is held to be inherent that there must be circuitry and/or software to carry this out. Watanabe does not expressly disclose orchestrating the center so as to determine whether the applied for identification document is to be issued or not based on the identification data for the applicant which has been recorded in the resident database and on the transmitted input data, but Sukegawa et al. teach this (column 7, line 36, through column 8, line 26; see also Figure 4). Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to determine whether or not the applied for identification document is to be issued or not based on the recorded identification data and the transmitted input data, for the obvious advantage of issuing identification documents to and only to the persons whom they are supposed to identify.

d. Watanabe does not expressly disclose that his invention is for passports, but does teach that it relates to a certification card with a certification photo, such as a driver's license or a personal identification card (column 1, lines 7-9), and passports are personal identification documents which generally contain certification photos. Hence, it would have been obvious to

Art Unit: 2165

one of ordinary skill in the art of identification document preparation at the time of applicant's invention to apply Watanabe's methods to producing passports.

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe (U.S. Patent 5,717,776) in view of Sukegawa et al. Watanabe discloses an identification document transaction apparatus connected through a communication line to a center which executes an examination for issuance of identification documents, as well as to a residents database which stores identification data of residents for providing services for issuing identification documents to residents, said apparatus comprising: a communication unit for communicating with said center (column 12, lines 31-33; see also Figure 10A); an image input unit for inputting an image of the applicant for an identification document (column 15, lines 1-31); and a data input unit for inputting data of the application (column 15, lines 21-40). Watanabe does not expressly disclose a control unit for transmitting the data inputted by each of the input units and the identification data of the applicant fetched using the communication unit to the center using the communication unit, but it is held to be inherent that there must be circuitry and/or software to carry this out. Watanabe does not expressly disclose orchestrating the center so as to determine whether the applied for identification document is to be issued or not based on the identification data for the applicant which has been recorded in the resident database and on the transmitted input data, but Sukegawa et al. teach this (column 7, line 36, through column 8, line 26; see also Figure 4). Hence, it would have been obvious to one of ordinary skill in the art of identification document

Art Unit: 2165

preparation at the time of applicant's invention to determine whether or not the applied for identification document is to be issued or not based on the recorded identification data and the transmitted input data, for the obvious advantage of issuing identification documents to and only to the persons whom they are supposed to identify.

a. Watanabe does not expressly disclose a display unit for displaying a guidance for the procedure for the identification document transaction, but Sukegawa et al. teach this (Figure 7; column 3, lines 21-24; column 8, lines 27-35 et subseq.). Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to include a display unit for displaying a guidance for the procedure, for the obvious advantage of making applicants more likely to carry out the procedure correctly.

b. Watanabe does not expressly disclose a sign input unit for inputting a sign of the applicant, but official notice is taken that it is well known to use sign input units for inputting a sign of an applicant. (For example, Examiner inputted his signature into such a unit to have a reproduction of his signature printed on his Virginia driver's license.) Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to include such a sign input unit, for the obvious advantage of obtaining the identification document applicant's signature for the identification document and/or for issuer's records.

c. Watanabe does not expressly disclose that his invention is for passports, but does teach that it relates to a certification card with a certification photo, such as a driver's license or a

Art Unit: 2165

personal identification card (column 1, lines 7-9), and passports are personal identification documents which generally contain certification photos. Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to apply Watanabe's methods to producing passports.

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe (U.S. Patent 5,717,776) in view of Sukegawa et al. Watanabe discloses an identification document apparatus which provides the data for issuance of a certificate for an applicant and executes examination for issuance of identification documents for processing identification documents through communication with the center via a communication line, said apparatus comprising: a communication unit for communicating with said center (column 12, lines 31-33; see also Figure 10A); an image input unit for inputting an image of the applicant for an identification document (column 15, lines 1-31); and a data input unit for inputting data for the identification document transaction (column 15, lines 21-40). Watanabe does not expressly disclose a control unit for controlling the communications by the communication unit, image input by the image input unit, display by the display unit, data input by the data input unit, and issuance by the issuer unit, but it is held to be inherent that there must be circuitry and/or software to carry out control. Watanabe does not expressly disclose orchestrating the center so as to determine whether the applied for identification document is to be issued or not based on the identification data for the applicant which has been recorded in the resident database and on the transmitted input data, but Sukegawa



Art Unit: 2165

et al. teach this (column 7, line 36, through column 8, line 26; see also Figure 4). Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to determine whether or not the applied for identification document is to be issued or not based on the recorded identification data and the transmitted input data, for the obvious advantage of issuing identification documents to and only to the persons whom they are supposed to identify.

a. Watanabe does not expressly disclose a display unit for displaying a guidance for the procedure for the identification document transaction, but Sukegawa et al. teach this (Figure 7; column 3, lines 21-24; column 8, lines 27-35 et subseq.). Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to include a display unit for displaying a guidance for the procedure, for the obvious advantage of making applicants more likely to carry out the procedure correctly.

b. Watanabe discloses a printer unit (Figure 2, element 57; see also column 5, lines 9-12). Watanabe does not expressly disclose that the printer unit prints the image inputted by the image input unit, but official notice is taken that it is well known to print images on passports, driver's licenses, passports, and other identification documents. Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to print the image, for the obvious advantage of producing a photographic identification document.

Art Unit: 2165

c. Watanabe discloses an issuer unit for issuing an identification document obtained by printing with the printer unit (column 16, lines 35-39).

d. Watanabe does not expressly disclose that his invention is for passports, but does teach that it relates to a certification card with a certification photo, such as a driver's license or a personal identification card (column 1, lines 7-9), and passports are personal identification documents which generally contain certification photos. Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to apply Watanabe's methods to producing passports.

8. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe and Sukegawa et al. as applied to claim 3 above. Watanabe discloses an identification document data input unit for inputting the contents of an issued identification document as data (column 4, lines 30-35; column 12, lines 26-30); and discloses orchestrating, when reissuing an identification document, the display unit and data input unit so as to amend the data required using data inputted from the identification document data input unit (column 12, line 41, through column 13, line 54).

9. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe and Sukegawa et al. as applied to claim 4 above. Watanabe discloses that an input unit reads the image of an issued identification document, and recognizes the characters in the read image in order to input the data (column 12, lines 26-30).

Art Unit: 2165

10. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe and Sukegawa et al. as applied to claim 3 above. Watanabe does not expressly disclose a receipt issuer unit for issuing receipt authorization data for checking an applicant when an identification document is issued to the applicant, but Sukegawa et al. teach this (column 9, lines 7-15). Neither Watanabe nor Sukegawa et al. disclose having the control unit determine whether the applied for identification document is to be issued or not by verifying the authorization in a storing unit, but official notice is taken that it is well known to provide or not provide a product or service to a customer according to whether it can be verified that he has paid for it. Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to have the control unit determine whether the applied for identification document is to be issued by verifying the receipt authorization, for the obvious advantage of issuing documents to, and only to, those who have paid for them.

a. Neither Watanabe nor Sukegawa et al. expressly disclose issuing receipt authorization data for checking an applicant when an identification document is issued on a later day, but official notice is taken that it is well known for receipts to be used to obtain goods or services on a later day (e.g., layaway plans). Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to issue receipt authorization data for checking an applicant when a passport was issued to the applicant on a later day, for the obvious advantage of easing issuance, when, for a variety of reasons, a passport could not be issued at once. (Reasons might include lack of stock of passport blanks, the need to

Art Unit: 2165

verify certain information, or summon human beings to make sensitive decisions, etc. For that matter, the present examiner has several times in his life applied for and obtained passports, and, if his recollection serves, passports were not issued until some days after he had gone to the Post Office, paid the requisite fees, submitted photographs, etc.)

11. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe and Sukegawa et al. as applied to claim 3 above. Watanabe does not expressly disclose that the image input unit is a digital camera, but does disclose that a CCD (charge-coupled device) rather than a conventional silver halide photographic system is used (column 15, lines 1-14). Official notice is taken that digital cameras are well known, particularly in association with CCD's; hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to use a digital camera, for the stated advantage of taking and storing a number of shots within a short time.

12. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe and Sukegawa et al. as applied to claim 3 above. Watanabe does not disclose, nor do Sukegawa et al. teach, that the apparatus further comprises a voice outputting unit for providing guidance by voice for the transaction procedure; or that the control unit outputs messages previously prepared with voice according to the progress of the transaction procedure by controlling the voice outputting unit. However, official notice is taken that it is well known to use voice outputting units to provide guidance by voice, and to have a control unit output messages previously prepared with voice according to the progress of a procedure by controlling the voice outputting

Art Unit: 2165

unit. (An example with which millions of people must be familiar, often to their frustration, is the kind of voicemail system in which previously prepared voice messages are outputted to the caller depending on his progress in selecting telephone buttons to press or answers to speak.)

Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to have the apparatus further comprise such a voice outputting unit for providing guidance, and to output messages previously prepared with voice according to the progress of the transaction procedure, for the obvious advantages of conveniently providing instructions to people who may be imperfectly literate, providing instructions by voice to save people the trouble of attempting to read instructions while at the same time entering data, and saving the expense of a display screen as opposed to a microphone.

13. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe and Sukegawa et al. as applied to claim 3 above. Watanabe does not disclose, nor do Sukegawa et al. teach, that the display unit is a display unit based on an integrated touch panel system, but official notice is taken that display units based on integrated touch panel systems are well known.

Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to employ a display unit based on an integrated touch panel system, for the obvious advantage of conveniently responding to a user's entries, and displaying appropriate instructions.

14. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe and Sukegawa et al. as applied to claim 3 above. Watanabe discloses a direct payment unit for

Art Unit: 2165

payment of a charge for identification document transaction with cash (Figure 3, elements 69 and 70; see also column 5, lines 50-56), wherein the input of bills and change is controlled by controlling the operations of the direct payment unit (Figure 2, elements 29 and 30; column 5, lines 50-56).

15. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe and Sukegawa et al. as applied to claim 3 above. Watanabe does not disclose that the communication unit is connected to a center of a financial institution, or that the apparatus further comprises an indirect payment unit for processing a charge for passport application through communication between the communication unit and the financial institution, but official notice is taken that it is well known to provide indirect payment means for processing a charge through communication with a financial institution (e.g., ATM machines, apparatus for accepting credit and debit cards in many shops, etc.). Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to have the apparatus further comprise an indirect payment unit, with a connection to a financial institution, for the obvious advantages of enabling document applicants to apply for identification documents without the inconvenience of carrying sufficient cash, and sparing the operators of the identification document transaction apparatus the need to deal with substantial amounts of cash.

16. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe and Sukegawa et al. as applied to claim 3 above. Watanabe discloses reading out data for issuing a certificate for the identification document applicant from the center with the communication unit

Art Unit: 2165

(column 12, lines 53-61), and printing the certificate based on the read-out data using the printing unit (e.g., column 7, lines 20-54).

17. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe and Sukegawa et al. as applied to claim 3 above. Watanabe discloses that a data input unit executes data input from a storage medium storing therein data required for transactions (column 12, lines 21-40).

18. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe (U.S. Patent 5,717,776) in view of Sukegawa et al. Watanabe discloses an identification card transaction apparatus for processing identification card transactions with a storage medium which stores the data required for issuance of identification cards and the data for identifying the applicants for the identification cards, said apparatus comprising: an image input unit for inputting an image of the applicant (column 15, lines 1-31); and a data input unit for inputting data for the application (column 15, lines 21-40). Watanabe does not expressly disclose a control unit for controlling the communications by the communication unit, image input by the image input unit, display by the display unit, data input by the data input unit, and issuance by the issuer unit, but it is held to be inherent that there must be circuitry and/or software to carry out control. Watanabe does not expressly disclose orchestrating the center so as to determine whether the applied for identification document is to be issued or not based on the identification data for the applicant which has been recorded in the resident database and on the transmitted input data, but Sukegawa et al. teach this (column 7, line 36, through column 8, line 26; see also Figure 4).

Art Unit: 2165

Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to determine whether or not the applied for identification document is to be issued or not based on the recorded identification data and the transmitted input data, for the obvious advantage of issuing identification documents to and only to the persons whom they are supposed to identify.

a. Watanabe does not expressly disclose a reader unit for reading out the data from the storage medium, but Sukegawa et al. teach this (element 42 in Figure 4).

b. Watanabe does not expressly disclose a display unit for displaying a guidance for the procedure for the identification document transaction, but Sukegawa et al. teach this (Figure 7; column 3, lines 21-24; column 8, lines 27-35 et subseq.). Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to include a display unit for displaying a guidance for the procedure, for the obvious advantage of making applicants more likely to carry out the procedure correctly.

c. Watanabe discloses a printer unit (Figure 2, element 57; see also column 5, lines 9-12). Watanabe does not expressly disclose that the printer unit prints the image inputted by the image input unit, but official notice is taken that it is well known to print images on passports, driver's licenses, passports, and other identification documents. Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to print the image, for the obvious advantage of producing a photographic identification document.



Art Unit: 2165

d. Watanabe discloses an issuer unit for issuing an identification document obtained by printing with the printer unit (column 16, lines 35-39).

e. Watanabe does not expressly disclose that his invention is for passports, but does teach that it relates to a certification card with a certification photo, such as a driver's license or a personal identification card (column 1, lines 7-9), and passports are personal identification documents which generally contain certification photos. Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to apply Watanabe's methods to producing passports.

19. Claims 15 and 16 closely parallel claims 4 and 5, respectively, and are rejected under 35 U.S.C. 103(a) on the same grounds.

20. Claim 17 closely parallels claim 6, and is rejected under 35 U.S.C. 103(a) on the same grounds.

21. Claim 18 closely parallels claim 7, and is rejected under 35 U.S.C. 103(a) on the same grounds.

22. Claims 19, 20, 21, and 22 closely parallel claims 8, 9, 10, and 11, respectively, and are rejected under 35 U.S.C. 103(a) on the same grounds.

23. Claim 23 closely parallels claim 12, and is rejected under 35 U.S.C. 103(a) on the same grounds.

24. Claim 24 closely parallels claim 13, and is rejected under 35 U.S.C. 103(a) on the same grounds.

Art Unit: 2165

25. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe and Sukegawa et al. as applied to claim 14 above. Watanabe discloses that data is read from an IC card (column 5, lines 57-65).

26. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe (U.S. Patent 5,717,776) in view of Sukegawa et al. Watanabe discloses an identification document transaction method applicable to a system in which a system is connected via communication line to a center for providing data for issuance of a certificate to an applicant and executing examination for issuance of an identification document for processing identification card transactions via communication with the center, said method comprising: a first step of inputting data for checking an applicant (column 12, lines 21-40); a third step of inputting, when it is determined that the applied for identification document is to be issued, an image of the applicant (column 15, lines 1-31); and a fourth step of printing the image of the applicant and the contents of the description inputted in the third step onto paper previously prepared, and issuing the identification document thus obtained by printing (column 2, lines 49-63). Watanabe does not expressly and unambiguously disclose a second step of accessing the center and determining whether the applied for identification document is to be issued or not by using data inputted for checking on an applicant, but Sukegawa et al. teach this (column 7, line 36, through column 8, line 26; see also Figure 4). Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to determine whether

Art Unit: 2165

or not the applied for identification document is to be issued according to the data read out, for the obvious advantage of issuing identification documents to and only to the persons whom they are supposed to identify.

a. Watanabe does not expressly disclose that his invention is for passports, but does teach that it relates to a certification card with a certification photo, such as a driver's license or a personal identification card (column 1, lines 7-9), and passports are personal identification documents which generally contain certification photos. Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to apply Watanabe's methods to producing passports.

27. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe (U.S. Patent 5,717,776) in view of Sukegawa et al. Watanabe discloses an identification document transaction method applicable for processing identification document transactions with a storage medium storing therein data required for issuance of identification documents as well as data for identifying applications for passports comprising: a first step of reading out data required for issuance of an identification document from the storage medium and data for identifying an applicant (column 12, lines 21-40); a third step of inputting, when it is determined that the applied for identification document is to be issued, an image of the applicant (column 15, lines 1-31); and a fourth step of printing the image of the applicant and the contents of the description inputted in the third step onto paper previously prepared, and issuing the identification document

Art Unit: 2165

thus obtained by printing (column 2, lines 49-63). Watanabe does not expressly and unambiguously disclose a second step of accessing the center and determining whether the applied for identification document is to be issued or not by using data inputted for checking on an applicant, but Sukegawa et al. teach this (column 7, line 36, through column 8, line 26; see also Figure 4). Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to determine whether or not the applied for identification document is to be issued according to the data read out, for the obvious advantage of issuing identification documents to and only to the persons whom they are supposed to identify.

a. Watanabe does not expressly disclose that his invention is for passports, but does teach that it relates to a certification card with a certification photo, such as a driver's license or a personal identification card (column 1, lines 7-9), and passports are personal identification documents which generally contain certification photos. Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to apply Watanabe's methods to producing passports.

28. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe (U.S. Patent 5,717,776) in view of Sukegawa et al. and Bradley et al. Watanabe discloses an identification document transaction system comprising: a center for executing examination for issuance of identification documents (Figure 2). Watanabe discloses that the center is connected

Art Unit: 2165

to a first database storing therein data for issuing certificates to applicants (column 12, lines 31-61). Watanabe does not disclose registering data for issuance of identification documents in a second database, but Bradley et al. teach this (column 1, lines 60-66). Furthermore, the duplication of known parts for a multiple effect is held to be obvious to one of ordinary skill in the relevant art [*St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8, 11; 549 F.2d 833 (7th Cir 1977); *In re Harza*, 124 USPQ 378, 380; 274 F.2d 669 (CCPA 1960)], from which the use of two databases is held to be obvious. Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to connect the center accessibly to first and second databases, for the obvious advantages of enabling the system to access data useful in determining whether to issue an identification document or not, and enabling the system to make records of identification document issuance data, so it will be possible to know how many identification documents have been issued, to whom they have been issued, and to obtain information about the persons to who they have been issued.

a. Watanabe discloses at least one passport transaction apparatus connected via a communication line to said center for processing identification document transactions by communicating with said center, wherein said identification document transaction apparatus comprises a communication unit for communicating with said center (column 12, lines 31-33); an image input unit for inputting an image of the applicant for an identification document (column 15, lines 1-31). Watanabe does not expressly disclose a control unit for controlling the communications by the communication unit, image input by the image input unit, display by the

Art Unit: 2165

display unit, data input by the data input unit, and issuance by the issuer unit, but it is held to be inherent that there must be circuitry and/or software to carry out control. Watanabe does not expressly disclose orchestrating the center so as to determine whether the applied for identification document is to be issued or not based on the identification data for the applicant which has been recorded in the resident database and on the transmitted input data, but Sukegawa et al. teach this (column 7, line 36, through column 8, line 26; see also Figure 4). Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to determine whether or not the applied for identification document is to be issued or not based on the recorded identification data and the transmitted input data, for the obvious advantage of issuing identification documents to and only to the persons whom they are supposed to identify.

b. Watanabe does not expressly disclose a display unit for displaying a guidance for the procedure for the identification document transaction, but Sukegawa et al. teach this (Figure 7; column 3, lines 21-24; column 8, lines 27-35 et subseq.). Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to include a display unit for displaying a guidance for the procedure, for the obvious advantage of making applicants more likely to carry out the procedure correctly.

c. Watanabe discloses a printer unit (Figure 2, element 57; see also column 5, lines 9-12). Watanabe does not expressly disclose that the printer unit prints the image inputted by the image input unit, but official notice is taken that it is well known to print images on passports, driver's

Art Unit: 2165

licenses, passports, and other identification documents. Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to print the image, for the obvious advantage of producing a photographic identification document.

d. Watanabe discloses an issuer unit for issuing an identification document obtained by printing with the printer unit (column 16, lines 35-39).

e. Watanabe does not expressly disclose that his invention is for passports, but does teach that it relates to a certification card with a certification photo, such as a driver's license or a personal identification card (column 1, lines 7-9), and passports are personal identification documents which generally contain certification photos. Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to apply Watanabe's methods to producing passports.

29. Claim 29 rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe, Sukegawa et al., and Bradley et al. as applied to claim 28 above. Watanabe discloses transmitting images to a file server, and storing them therein (column 15, lines 20-35; see also column 4, lines 36-42); thus the image input unit and communication unit are connected to each other, and the control unit transfers the image inputted by the image input unit via the communication unit to the center.

30. Claim 30 rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe, Sukegawa et al., and Bradley et al. as applied to claim 28 above. Watanabe does not expressly

Art Unit: 2165

disclose a voice inputting unit and voice outputting unit, nor does Watanabe disclose that the communication unit transfers the voice inputted with the voice input unit to the center and also outputs the voice transferred from the center to the voice outputting unit. However, official notice is taken that voice inputting and voice outputting units are well known, and further, that it is well known to transfer voices from one location to another. (Telephones are the obvious example of apparatus for doing so, and telephones, of course, also include voice input and output units.) Hence, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to include voice input and output units, and to transfer voices to and from the center, for the obvious advantage of facilitating communications between a remote user and the center.

31. Claims 31 and 32 closely parallel claims 10 and 11, respectively, and are rejected under 35 U.S.C. 103(a) on the same grounds.

32. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe (U.S. Patent 5,717,776) in view of Sukegawa et al. and Bradley et al. Watanabe discloses an identification document transaction system comprising: a first center having a first database with data required for issuance of identification documents (Figure 2; column 12, lines 31-61). Watanabe does not disclose a second center for registering data for issuance of identification documents in a second database and also executing examination for issuance of passports, but Bradley et al. teach such a database (column 1, lines 60-66). Furthermore, the duplication of



Art Unit: 2165

known parts for a multiple effect is held to be obvious to one of ordinary skill in the relevant art [*St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8, 11; 549 F.2d 833 (7th Cir 1977); *In re Harza*, 124 USPQ 378, 380; 274 F.2d 669 (CCPA 1960)], from which the use of two centers is held to be obvious. Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to include first and second centers with corresponding databases, for the obvious advantages of enabling the system to access data useful in determining whether to issue an identification document or not, and enabling the system to make records of identification document issuance data, so it will be possible to know how many identification documents have been issued, to whom they have been issued, and to obtain information about the persons to who they have been issued.

a. Watanabe discloses at least one passport transaction apparatus connected via a communication line to a center for processing identification document transactions by communicating with the center, wherein said identification document transaction apparatus comprises a communication unit for communicating with said center (column 12, lines 31-33); an image input unit for inputting an image of the applicant for an identification document (column 15, lines 1-31). Watanabe does not expressly disclose a control unit for controlling the communications by the communication unit, image input by the image input unit, display by the display unit, data input by the data input unit, and issuance by the issuer unit, but it is held to be inherent that there must be circuitry and/or software to carry out control. Watanabe does not expressly disclose orchestrating the center so as to determine whether the applied for

Art Unit: 2165

identification document is to be issued or not based on the identification data for the applicant which has been recorded in the resident database and on the transmitted input data, but Sukegawa et al. teach this (column 7, line 36, through column 8, line 26; see also Figure 4). Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to determine whether or not the applied for identification document is to be issued or not based on the recorded identification data and the transmitted input data, for the obvious advantage of issuing identification documents to and only to the persons whom they are supposed to identify.

b. Watanabe does not expressly disclose a display unit for displaying a guidance for the procedure for the identification document transaction, but Sukegawa et al. teach this (Figure 7; column 3, lines 21-24; column 8, lines 27-35 et subseq.). Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to include a display unit for displaying a guidance for the procedure, for the obvious advantage of making applicants more likely to carry out the procedure correctly.

c. Watanabe discloses a printer unit (Figure 2, element 57; see also column 5, lines 9-12). Watanabe does not expressly disclose that the printer unit prints the image inputted by the image input unit, but official notice is taken that it is well known to print images on passports, driver's licenses, passports, and other identification documents. Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's

Art Unit: 2165

invention to print the image, for the obvious advantage of producing a photographic identification document.

d. Watanabe discloses an issuing unit for issuing an identification document obtained by printing with the printer unit (column 16, lines 35-39).

e. Watanabe does not expressly disclose that the first center verifies the data inputted by the data input unit according to a request for verification of an applicant for an identification document from the identification document transaction apparatus to the first database by way of communication with the communication unit and returns a reply according to a result of verification as to whether the applicant is the person he claims to be or not, but Sukegawa et al. teach this (column 7, line 36, through column 8, line 26; note also elements 10 and in particular 3 in Figure 1). Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to have the first center verify the data in such a manner, for the obvious advantage of determining whether an identification document applicant is the person he claims to be.

f. Watanabe does not disclose, nor do Sukegawa et al., that a second center verifies the data inputted by the input center, etc., but, as stated above, in the first subparagraph of this rejection, the duplication of known parts to obtain a multiple effect is held to be obvious to one of ordinary skill in the art.

g. Watanabe does not expressly disclose that his invention is for passports, but does teach that it relates to a certification card with a certification photo, such as a driver's license or a

Art Unit: 2165

personal identification card (column 1, lines 7-9), and passports are personal identification documents which generally contain certification photos. Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to apply Watanabe's methods to producing passports.

33. Claim 34 is closely parallel to claim 29, and is therefore rejected under 35 U.S.C. 103(a) on the same grounds.

34. Claim 35 is closely parallel to claim 30, and is therefore rejected under 35 U.S.C. 103(a) on the same grounds.

35. Claims 36 and 37 closely parallel claims 10 and 11, respectively, and are rejected under 35 U.S.C. 103(a) on the same grounds.

#### ***Response to Arguments***

36. Applicant's arguments filed June 29, 2001 (and entered with the CPA of August 8, 2001), have been fully considered but they are not persuasive. Applicant argues that Watanabe (U.S. Pat. 5,717,776) and Sukegawa (U.S. Pat. 5,235,165) fail to disclose, singly or in combination, a passport data input unit for inputting the contents of an issued passport as data, as set forth in claims 4 and 15. Examiner is not persuaded that this failure renders any of Applicant's claims nonobvious, taking into consideration that Watanabe does disclose inputting the contents of an issued driver's license as data (column 4, lines 30-35; column 12, lines 26-30). Driver's licenses

Art Unit: 2165

and passports are both identification documents; what is anticipated for one is held to be obvious to a person having ordinary skill in the art for the other.

Applicant also argues that the applied references do not disclose issuing a passport on a later day, as set forth in amended claim 6. Again, Examiner is not persuaded that the deficiency of the cited prior art to disclose the precise limitation claimed makes the claim or claims nonobvious. As set forth in the rejection of claim 6 (*vide supra*), it is known to make a good or service available on a later day (as in layaway plans), and Examiner believes that it is also old and well known not to issue a passport until some days after payment of the passport application fee, and the meeting of other requirements (because, inter alia, U.S. passports were not physically prepared at most of the sites where they were applied for, but required time to prepare and transport).

### ***Conclusion***

37. Any inquiry concerning this communication or earlier communications from the examiner should be addressed to Nicholas D. Rosen, whose telephone number is (703) 305-0753. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Wynn Coggins, can be reached at (703) 308-1344. The fax number for this Group is (703) 308-1396.

Art Unit: 2165

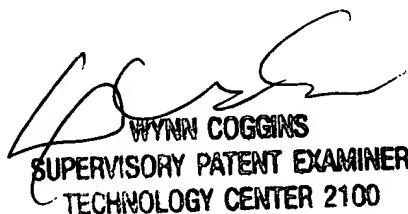
Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to Nicholas.Rosen@uspto.gov.

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark Office on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist, whose telephone number is (703) 305-3900.

*Nicholas D. Rosen*  
Nicholas D. Rosen

September 30, 2001

  
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